



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/339,076 06/23/99 TRACY

J VDLT.66937

EXAMINER

QM12/0301

WILLIAM B KIRCHER
SHOOK HARDY & BACON LLP
ONE KANSAS CITY PLACE
1200 MAIN STREET
KANSAS CITY MO 64105-2118

WHITE, C

ART UNIT

PAPER NUMBER

3713

DATE MAILED:

03/01/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/339,076

Applicant(s)

TRACY ET AL.

Examiner

Carmen D. White

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____.

Art Unit: 3713

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 1 recites the limitation "the game" in line 7 of the claim. There is insufficient antecedent basis for this limitation in the claim.

4. Claim 33 recites the limitation "the individual game" in line 6 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 3713

6. Claims 1 & 15 & 33, 2-3 & 9 & 17-18 & 24, 4 & 19, 5 & 10 & 20 & 25, 16, 28, 29, 30, 31 and 32 are provisionally rejected under the judicially created doctrine of double patenting over claims 6 & 7, 9, 10, 12, 8, 13, 14, 15, 16, and 18, respectively, of copending Application No. 09/106,659. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: the steps of forming groups of entrants who have wagered on a first individual game and a second group participation game; determining the winners of both games at the conclusion of the games.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

Art Unit: 3713

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 1, 11, 15, 28, and 30-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Byrne.

Regarding claims 1, 15, 28 and 30, Byrne discloses the steps of forming a group of game entrants who have made a first wager on the outcome of a first game {Keno} and a second wager on the outcome of a second, group participation game {Super Keno}; and determining winners for the first game {Keno} and the second group game {Super Keno}. The group of game entrants could consist of all the entrants of the first game or at least some of the entrants of the first game, depending on whether or not the game entrants wish to participate in the second group game (see lines 1-12 of the abstract; col. 1, lines 38-43 and 57-64; col. 2, lines 19-36).

Regarding claim 11, Byrne discloses all the limitations of the claim as discussed above. Byrne further discloses the feature of the entrants of a game being allowed to wager different amounts, and get paid an amount proportional to the amount wagered (co. 1, lines 36-67).

Regarding claim 31, Byrne discloses all the limitations of the claim, further including the feature of plural electronic gaming machines (Fig. 2 and lines 10-12 of the abstract).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3713

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 12-14, 26-27 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne.

Regarding claims 12-13, 26-27 & 34, Byrne discloses all the limitations of the claims as discussed above. Byrne lacks disclosing the feature of each game entrant wagering a fixed amount. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the fixed wager feature as a matter of design choice. It is well-known in the gaming art to allow players to bet a fixed amount and receive an amount proportionate to the fixed amount as a payout.

Regarding claims 14 and 33, Byrne discloses all the limitations of the claims as discussed above. Byrne lacks disclosing the determination of the outcome of the group game before the outcome of the first wagering game. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Byrne to include this feature as a means of design choice. This feature would increase the excitement and anticipation of the game results.

Regarding claim 35, Byrne discloses all the limitations of the claim as discussed above. Byrne lacks disclosing the feature of applying the winning outcome to the group game only if the first game has a winning outcome. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in

Art Unit: 3713

Byrne because it is well-known in the gaming art to have "all or nothing" outcomes to games. This increases player anticipation and excitement to play the game.

11. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of Koza et al.

Regarding claim 32, Byrne discloses all the limitations of the claim as discussed above. Byrne lacks in disclosing a lottery game. Instead Byrne discloses a Keno game of chance. In an analogous game of chance system, Koza et al discloses a lottery game. It would have been obvious to a person of ordinary skill in the art to substitute the lottery game of chance of Koza et al in the place of the Keno gaming system of Byrne because lottery games are a well-known form of chance games that generate high interest and player participation.

12. Claims 2-5, 9-10, 17-20, 24-25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of Marnell II.

Regarding claims 2-5, 9-10, 17-20, 24-25, Byrne discloses all the limitations of the claim as discussed above. Byrne lacks disclosing the feature of randomly generating indicia in an array and comparing at least a portion of the array with a predetermined combination of indicia. Instead Byrnes discloses a gaming system that includes Keno. In an analogous gaming system, Marnell II discloses a gaming machine that includes a poker game feature that performs the function of randomly generating indicia and comparing at least a portion of the array with a predetermined combination of indicia (Fig. 4, #62 and col. 8, lines 23-45). The art benefits from the random feature

Art Unit: 3713

of Marnell II's teaching by making the gaming system less susceptible to cheating attempts. One skilled in the art would understand Marnell II's teaching as being a critical feature of poker type gaming devices. It would have been obvious to one of ordinary skill at the time of the invention to include random generation of indicia (poker machine) of Marnell II in the invention of Byrne to make a gaming device with multiple game features. This would increase the player's excitement for playing the gaming device.

Regarding claim 29, Byrne discloses all the limitations of the claim as discussed above. Byrne lacks in disclosing a bingo game. Instead Byrnes discloses a gaming system that includes Keno, which is similar to bingo. Marnell II discloses a bingo gaming system (Fig. 1, #47). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the bingo game feature of Marnell II in the gaming system of Byrne because bingo gaming systems are well-known in the gaming art.

13. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of Weiss.

Regarding claim 16, Byrne discloses all the limitations of the claim as discussed above. Byrne lacks in disclosing the feature of forming a group of all winners of the individual participation wagering game. Instead Byrne teaches a gaming system with an individual participation and a group participation game whereby the individuals who desire to participate in the group game pay a fee and are then entered into the group

Art Unit: 3713

game. In the analogous gaming system of Weiss, players participate in a first and a second game. Weiss teaches the feature of forming a group of winners of a first individual game (col. 6, lines 24-39). The art benefits from this claim feature by providing a system that rewards a player's skill and judgment (Weiss- col. 2, lines 60-62). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the feature of forming a group of winners of Weiss in the gaming system of Byrne to increase consumer interest so that the gaming establishment can enjoy greater participation.

14. Claims 6-8 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of Marnell II, further in view of Barrie.

Regarding claim 6, 8, 21 and 23, Byrne in view of Marnell II discloses all the limitations of the claim as discussed above. Byrne and Marnell II lack disclosing the feature of multipliers on a slot machine wheel device. Barrie discloses the use of multiplier symbols on a simulated slot machine wheel display. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the multiplier feature of Barrie in the electronic gaming systems of Byrne and Marnell II in order to increase the amount of the payout to the players, thereby improving player participation at the gaming devices.

Regarding claims 7 and 22, Byrne in view of Marnell II, further in view of Barrie discloses all the limitations of the claims, as discussed above. While Byrne, Marnell II and Barrie disclose electronic gaming systems, the references lack disclosing the a

Art Unit: 3713

mechanical wheel gaming device. It would have been obvious to a person of ordinary skill in the art at the time of the invention to employ a mechanical wheel in the gaming machine invention of Byrne, Marnell II, and Barrie because it is well-known in the art of slot machines to use mechanical wheels, as a matter of design choice.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Celona, Weingardt, Weiss and Franchi disclose gaming systems with multiple game features.

Contact Information

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday-Friday, 8:30 am- 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for regular communications and 703-308-3579 for After Final communications.

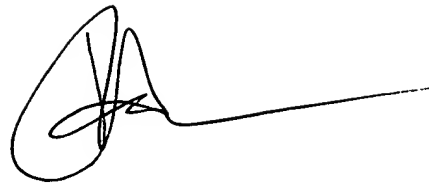
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

Art Unit: 3713

A handwritten signature in cursive script that reads "Carmen White".

Carmen White
Patent Examiner

February 25, 2000

A handwritten signature in cursive script, likely reading "Jessica J. Harrison", followed by a long horizontal line.

JESSICA J. HARRISON
PRIMARY EXAMINER